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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,687	02/25/2004	Mark A. Voves	P06555US1	3013
34082	7590	05/25/2005	EXAMINER	
ZARLEY LAW FIRM P.L.C. CAPITAL SQUARE 400 LOCUST, SUITE 200 DES MOINES, IA 50309-2350			PRONE, JASON D	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/786,687	Applicant(s) VOVES, MARK A.	
	Examiner Jason Prone	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Grand (1,196,252) in view of Wang (6,305,249).

In regards to claim 1:

Le Grand discloses the invention including an elongate body (10) having a forward end with an enclosed first compartment having a shape to receive and engage the shank of a punch (12), a plunger slidably mounted in the body (18) and having a forward end in the enclosed compartment (17), a spring associated with the plunger disposed within a second compartment and yieldingly urging the plunger into the enclosed first compartment (19), an elongated slot in the body (11), and a handle secured to the plunger and extending outwardly through the slot to permit manual grasping thereof to pull the plunger rearwardly against the spring (19).

However, Le Grand fails to disclose a third storage compartment within the body. Wang teaches a third storage compartment within a body (27). Therefore, it would have been obvious to one of ordinary skill in the art, to have provided Le Grand with a third storage compartment, as taught by Wang, for added convenience so the user can have

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all the necessary tools at his/her disposal and not interfere with the components of the apparatus.

In regards to claims 8 and 10:

Le Grand discloses the invention including an elongate body (10) having a forward end with an enclosed first compartment having a shape to receive and engage the shank of a punch (12), a plunger slidably mounted in the body (18) and having a forward end in the enclosed compartment (17), a spring associated with the plunger disposed within a second compartment and yieldingly urging the plunger into the enclosed first compartment (19), an elongated slot in the body (11), and a handle secured to the plunger and extending outwardly through the slot to permit manual grasping thereof to pull the plunger rearwardly against the spring (19).

However, Le Grand fails to disclose a frusto-shaped enclosed first compartment having a flat head and tapered side walls and a third storage compartment within the body. Wang teaches a frusto-shaped enclosed first compartment having a flat head and tapered side walls (24) and a third storage compartment within a body (27). Therefore, it would have been obvious to one of ordinary skill in the art, to have provided Le Grand with a frusto-shaped enclosed first compartment and a third storage compartment, as taught by Wang, to allow the tool to conform to the old and well known shape of most shanks and to provide added convenience so the user can have all the necessary tools at his/her disposal and not interfere with the components of the apparatus.

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3. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Grand in view of Wang as applied to claims 1 and 8 above, and further in view of Wyler et al. (3,933,148). Le Grand in view of Wang disclose the invention but fail to disclose a threaded plug that engages the spring to adjust the compression of the spring. Wyler et al. teaches that it is old and well known to adjust the compression of a spring with a threaded plug (5). Therefore, it would have been obvious to one of ordinary skill in the art, to have provided Le Grand in view of Wang with a threaded plug that engages the spring to adjust the compression, as taught by Wyler et al., to allow the spring to apply a stronger force to the object the spring is biasing.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Le Grand in view of Wyler et al. Le Grand discloses the invention including an elongate body (10) having a forward end with an enclosed first compartment having a shape to receive and engage the shank of a punch (12), a plunger slidably mounted in the body (18) and having a forward end in the enclosed compartment (17), a spring associated with the plunger disposed within a second compartment and yieldingly urging the plunger into the enclosed first compartment (19), an elongated slot in the body (11), and a handle secured to the plunger and extending outwardly through the slot to permit manual grasping thereof to pull the plunger rearwardly against the spring (19').

However, Le Grand fails to disclose a threaded plug that engages the spring to adjust the compression of the spring. Wyler et al. teaches that it is old and well known to adjust the compression of a spring with a threaded plug (5). Therefore, it would have been obvious to one of ordinary skill in the art, to have provided Le Grand in view of

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Wang with a threaded plug that engages the spring to adjust the compression, as taught by Wyler et al., to allow the spring to apply a stronger force to the object the spring is biasing.

5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Grand in view of Wyler et al. as applied to claims 1 and 8 above, and further in view of Wang. Le Grand in view of Wyler et al. disclose the invention but fail to disclose a frusto-shaped enclosed first compartment having a flat head and tapered side walls and a third storage compartment within the body. Wang teaches a frusto-shaped enclosed first compartment having a flat head and tapered side walls (24) and a third storage compartment within a body (27). Therefore, it would have been obvious to one of ordinary skill in the art, to have provided Le Grand in view of Wyler et al. with a frusto-shaped enclosed first compartment and a third storage compartment, as taught by Wang, to allow the tool to conform to the old and well known shape of most shanks and to provide added convenience so the user can have all the necessary tools at his/her disposal and not interfere with the components of the apparatus.

Response to Arguments

6. Applicant's arguments with respect to claims 1 and 4-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Flyckt, Fish, Kissinger, and Barbulescu et al.

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 571-272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JP
May 17, 2005



Allan N. Shoap
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